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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,815	12/06/2000	Daniel Newman	2717.100	9252

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,815

Applicant(s)

NEWMAN, DANIEL

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59, 61 and 63-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59, 61 and 63-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-05-05</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

Status of Claims

1. Claims 1-59, 61 and 63-75 have been examined.

Response to Amendments

2. Applicant's arguments with respect to claims 1-59 and 61-71 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner would like to remind the Applicant that "intended use" language (i.e. "adapted to") does not distinguish the claimed (e.g. claims 3, 4, 61 and 66) apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114, Ex parte Masham, 2 USPQ2d 1647 (1987)). Regarding claim 55, browsers require at least an operating system, processor and memory to run, therefore the Examiner is interpreting claim 55 as reading "wherein the client information appliance operates *with* a processing program associated with a browser" (see claims 7 and 35). Regarding claims 63-65, the Examiner also reminds the Applicant that,

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106, II, C).

Therefore, in order for the prior art to effectively read on the prior art need only teach payment processing for content and items that are not pre-authorized.

Newly added claims 72-75 are also rejected and are addressed below.

The following assertion of facts have gone unchallenged and are considered admitted prior art:

- messages to users indicating “insufficient funds” or “overdrawn” are old and well known

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-59, 61 and 63-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claims 1, 5, 33, 58, 61, 63, 66, 69-71, 74, and 75 recite “wherein the user defined parameters are not used to perform a search for content”. However, it is not clear to one of ordinary skill how Applicant’s system can guarantee that a user will not use self-imposed financial constraints to guide a search for content or that the system can detect such use as this is a mental step.

Claims 2-4, 6-32, 34-57, 59, 64, 65, 67, 68, 72, and 73 are also rejected as each depends from claims 1, 5, 33, 58, 61, 63, 66, 69-71, 74, or 75.

b. Claim 5 recites accessing selected content "... without obtaining further authorization prior to accessing". However, Applicant has also amended the claim to remove the limitation of a user "selecting content through the network". Claim 33 has been similarly amended. Applicant describes in the Specification a user browsing online and accessing content without authorization (Specification, pages 27-32) but to one of ordinary skill there is necessarily an authorization (e.g. a "selecting" step or "buy" step of Daly et al., figure 5) prior to "accessing" otherwise a user will be charged for content the he or she does not desire ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous", *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Note, this analysis also applies to similar claims 15, 17, 39, 58, 61, 66, and 70.

Claims 6-32, 34-57, 59, 67, 68 are also rejected as each depends from claims 5, 33, 58, 66.

c. Claim 5 recites the limitation "selected content" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 6-32 are also rejected as they depend from claim 5.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5-15, 17-26, 28, 29, 31-37, 39-42, 46-56, 58, and 63-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Daly et al., U.S. Patent No. 5,878,141.

As per claims 1, 3, 5-15, 17, 18, 20, 22-26, 28, 29, 31-37, 39-42, 46-52, 54-56, 58, and 69-75, Krishnan et al. teach a method and system for receiving fee-based content comprising:

- displaying a first portion of content-provider content to a user at a user location (figures 2, 7 and 12; column 9, lines 30-33),
determining whether a second portion of content requires payment (figure 12), displaying the second portion of content after payment (i.e. playing the game or using the software) (figures 12 and 13;

column 6, lines 56-62), and accumulating a plurality of fees incurred by the user at a third party location (figures 12 and 14)

- implementing a digital wallet using a browser application (figures 14-18; column 21, lines 3-8)
- collecting content from a plurality of content providers as a function of HTML (figures 1, 2 and 7; column/line 3/23-4/10)

Regarding third party providers, Krishnan et al. disclose a user paying for content using a credit card (e.g. other users) (figures 14-18), hence Krishnan et al. teach a user making payments and overpayments (e.g. claims 28 and 48) to a third party provider, individual and accumulated fee thresholds, and said provider accumulating user charges, verifying fees, billing a user, storing user account and paying a content provider on behalf of a user. Krishnan et al. teach providing payment for content using a digital wallet (column 21, lines 2-21). However, Krishnan et al. do not specifically recite digital wallets with spending controls. Daly et al. teach user imposed spending controls on a digital wallet (figure 7; column 8, lines 12-20; column 12, lines 53-65) including the acceptance (or preauthorization) of all goods and services fees below a preset amount, a limit on the quantity of fees over a time period (i.e. account limit prior to card expiration date) (figure 7; column 6, lines 3-24), and individual and accumulated fee thresholds (figure 7; column 6, lines 3-24) where said control parameters are not used as entered search parameters. Messages from third party providers to

users indicating "insufficient funds" or "overdrawn" are old and well-known, hence as Daly et al. teach denying transactions that exceed a predetermined amount (figure 7; column 13, lines 4-35) it would have been obvious to one of ordinary skill to convey this fact (i.e. lack of funds) to the user. Daly et al. also teach a user accessing a third party provider terminal for establishing and storing user preferences associated with wallet spending controls (figure 1; column 6, lines 3-36; column 17, lines 17-47). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al. and Daly et al. in order to prevent excessive purchases and to better secure user credit card information ('141, column 6, lines 3-24; column 8, lines 12-20).

As per claim 19, logging onto a computer is old and well-known.

As per claim 21, it is well-known that companies such as Comcast, Verizon, Bell South, MSN and AOL charge fees for accessing the internet. Therefore, "internet access" is "at least some of the fees" that a user accumulates for making purchases online.

As per claim 53, both Krishnan et al. (figures 14-18) and Daly et al. (figures 2 and 5; column 5, lines 60-67) teach a user paying for goods and services via a third party such as a credit card company. Credit card companies authorize payments for transactions made over the internet. In order to connect to the internet said companies pay a fee to an internet service provider such as Verizon, Comcast or Bell South, hence a credit card company [payment

appliance for authorizing transactions over the internet] is associated with an ISP.

As per claims 63-68, the Krishnan et al. system at least suggests to one of ordinary skill a user purchasing multiple items (figures 2, 7 and 17).

7. Claims 2, 4, 14, 16, 27, 43-45, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 and Daly et al., U.S. Patent No. 5,878,141, as applied to claims 1 above, and in further view of Casement et al., U.S. Patent No. 5,969,748.

As per claims 2, 4, 14, 16, 27, 43-45, and 65, Krishnan et al. teach a method for making online purchases using a digital wallet (figures 12 and 14). Daly et al. teach digital wallet spending controls (figure 7; column 6, lines 3-24; column 8, lines 12-20). However, neither Krishnan et al. nor Daly et al. explicitly recite prompting a user for acceptance of charges that exceed a predetermined spending limit. Casement et al. teach spending controls for obtaining a second portion of content if a charge associated with said second portion does not exceed a predefined limit (abstract; figures 2F-H and 5; column 5, lines 40-51). Casement et al. also recite prompting a user for acceptance of charges that exceed the predetermined spending limit (figure 5; column 5, lines 40-51) and limiting access to predetermined content providers and restricting access to content based on content type (figures 2C-E). Therefore, it would have been

obvious to one of ordinary skill to combine the teachings of Krishnan et al., Daly et al. and Casement et al. in order to provide a user with more control and choices over how he/she is to use his/her wallet. For example, a family can share a single wallet or account and spending controls can be applied to the children while more responsible members (i.e. parents) are able to use the card more freely ('141, column 6, lines 13-24; '748, figure 5; column 5, lines 40-51).

8. Claims 7, 30, 35 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 and Daly et al., U.S. Patent No. 5,878,141, as applied to claims 5 and 33 above, and in further view of Nelson, U.S. Patent No. 6,058,381.

As per claims 7, 30, 35, and 57, Krishnan et al. teach a method for making online purchases using a digital wallet (figures 12 and 14). Daly et al. teach digital wallet spending controls (figure 7; column 6, lines 3-24; column 8, lines 12-20). However, neither Krishnan et al. nor Daly et al. teach multiple currencies. Nelson discloses payments from a digital wallet using electronic cash (column 3, lines 50-58; column 5, lines 22-33). Nelson also discloses integrating a wallet in a browser (column 5, lines 22-33). Therefore, it would have been obvious to one of ordinary skill to combine the teachings Krishnan et al., Daly et al. and Nelson to provide users with the option to make a payment in virtual money if the user fears dishonesty on the part of the seller, or vice versa ('381, column 3, lines 50-58).

9. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 and Daly et al., U.S. Patent No. 5,878,141, as applied to claims 33 above, and in further view of Langhans et al., U.S. Patent No. 5,500,513.

As per claim 38 Krishnan et al. teach a method for making online purchases using a credit card embodied in a digital wallet (figures 12 and 14). Daly et al. teach digital wallet spending controls (figure 7; column 6, lines 3-24; column 8, lines 12-20). However, neither Krishnan et al. nor Daly et al. explicitly teach accepting a preselected number of fees. Langhans et al. teach a system for controlling credit card purchases based on spending parameters (abstract; figures 5-7, 10 and 11; column/line 14/55-16/16) such as the number of charges over a preselected period of time (column 11, lines 35-63; column 13, lines 25-46). Langhans et al. also teach overrides (column 9, lines 15-21). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al., Daly et al. and Langhans et al. in order provide improved fraud detection ('513, column 1, lines 47-6)

10. Claims 58, 59, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al., U.S. Patent No. 6,073,124 in view of Daly et al., U.S. Patent No. 5,878,141 and Berstis et al., U.S. Patent No. 6,282,653.

As per claims 58, 59, and 61, Krishnan et al. teach a method for making online purchases using a credit card embodied in a digital wallet (figures 12 and 14). Daly et al. teach digital wallet spending controls for pre-authorizing the retrieval of content that requires a fee (figure 7; column 6, lines 3-24; column 8, lines 12-20). However, neither Krishnan et al. nor Daly et al. explicitly teach royalty payments. Berstis et al. teach a method and system for accumulating fees, accepting said fees from a user for accessing content and disseminating royalty payments based on said fee (column 8, lines 9-35; column 9, lines 45-53). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Krishnan et al., Daly et al. and Berstis et al. in order to facilitate the efficient compensation of copyright holders for the use of their IP ('653, column 1, 30-67; '124, figures 2 and 7).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Nikander et al. teach a user paying an ISP who in turn pays a seller

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

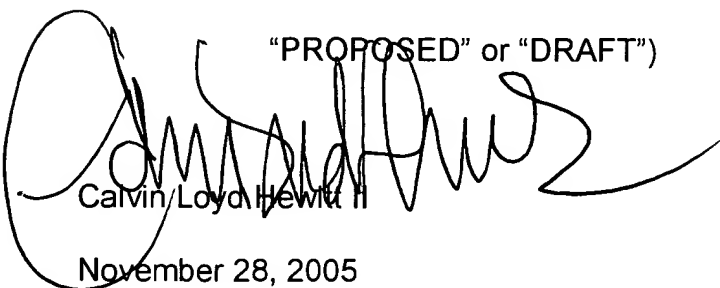
Art Unit: 3621

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

A handwritten signature in black ink, appearing to read "Calvin Lloyd Hewitt II". The signature is written in a cursive, flowing style with a large initial "C".

Calvin Lloyd Hewitt II

November 28, 2005